

Response to Non-Final Office Action dated 5/15/08

Application No.: 09/956,910

**Remarks**

The non-final Office Action mailed May 15, 2008 ("Action") has been received. In reply, claims 8, 113, and 135 have been cancelled and claims 149-151 have been added. Reconsideration and allowance based on the following remarks is respectfully requested.

**Remarks on Personal Interview and Comments made in Action**

A personal interview was conducted for this application on February 5, 2008. The interview summary of February 5, 2008 indicated:

*reached, or any other comments: Discussed the prior arts of record with respect to the claimed invention. Applicant intends to amend the claims to read "mobile phone" instead of "mobile terminal" which will overcome the prior arts of record. Upon receipt of a proper response to the last office action, an appropriate action will be made accordingly.*

The interview summary was signed by the examiner, as reproduced below:



Examiner's signature, if required

Notably, the interview summary indicates that amending "the claims to read 'mobile phone' instead of 'mobile terminal' . . . will overcome the prior arts of record." Emphasis added. The previous response made such an amendment to the claims and it was expected that the claims would be allowed unless a new reference was found in an updated search. This did not occur.

Instead, the Office has maintained its position on the *same* prior art after Applicants made an amendment that the examiner indicated would "overcome the prior arts of record." Applicants are unclear why the Office has reversed course when it was believed that agreement had previously been reached on this claim amendment during the interview, and the Office Action relies only on the same references which were previously discussed with and dismissed by the Examiner. Nevertheless, Applicants submit the following comments.

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**Claim Rejections Under 35 U.S.C. § 103**

Claims 1-15, 17, 28, 36, 44, 53, 63, 74, 86, 92, 94-98, 103-126, 131-143, and 148 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hind in view of U.S. Patent Application Publication No. 2005/0028208 to Ellis (“Ellis”). Claims 99-102, 127-130, and 144-147 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hind in view of Ellis, in further view of U.S. Patent No. 6,564,047 to Steele et al. (“Steele”). Applicants respectfully traverse for at least the reasons set forth below.

**1. Comments on Claims 1-7, 10-15, 17, 28, 94-102, 106, and 108-109**

Claim 1 has been amended to recite “transmitting inhibit rule data directly from said second mobile phone to said first mobile phone via the secured communication link, wherein the inhibit rule data is configured to instruct the first mobile phone to inhibit certain functions of said first mobile phone so that said functions are no longer operable by said first mobile phone.” Claims 2-7, 10-15, 17, 28, 94-102, 106, and 108-109 depend from claim 1. For at least the following reasons, the combination of Ellis, Hind, and Steele, even if proper, does not teach or suggest the above identified combination of features recited in claim 1.

Hind does not anticipate the “inhibit rule data” recited in amended claim 1. On page 5, the Action notes that:

**Hind discloses authentication process between a first mobile terminal and a second mobile terminal, as illustrated in various embodiments in figs. 1-6 (col. 7, lines 30-39, col. 9, lines 16-61 and col. 12, lines 20-42), but silent to inhibiting certain functions of the first mobile so that the functions are no longer operable and further is silent as to where the second device is a mobile phone.**

Action at 5. Particularly, the Action correctly notes that Hind is “silent to inhibiting certain functions of the first mobile so that the functions are no longer operable.” Action at 5. Claim 1 has been amended to recite that “the inhibit rule data is configured to instruct the first mobile phone to inhibit certain functions of said first mobile phone so that said functions are no longer operable by said first mobile phone.” Thus, Hind necessarily fails to teach or suggest “transmitting inhibit rule data directly from said second mobile phone to said first mobile phone via the secured communication link.”

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Ellis also fails to disclose the claimed transmission of inhibit rule data directly from a second mobile phone to a first mobile phone via a secured communication link. FIG. 2a of Ellis is reproduced below.

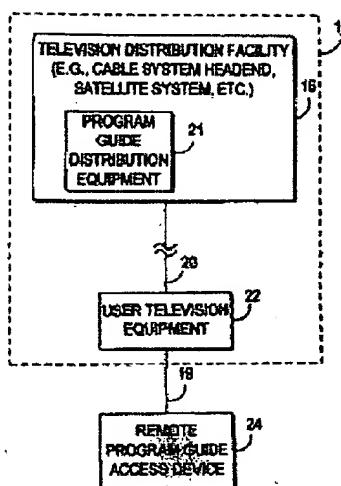


FIG. 2a

Ellis describes sending parental control settings from remote program access device 24 to user television equipment 22. Ellis at ¶ 0071.

Notably, Ellis does not describe either the remote program guide access device (RPGAD) 24 or the user television equipment 22 as being mobile phones. In fact, the Action correctly notes that the RPGAD 24 is not a mobile phone, by stating that:

[0120-0121]. Ellis further discloses that the Ra-24 includes communication link 19, i.e., serial port, parallel port, modem (analog or digital, cellular modem, cable modem, etc., ([0088]) and further discloses that Ra-24, includes voice processor and speaker, etc., (features of a cellular phone, see ([0092], [0108-0109], [0114], [0122] and [0127])).

Action at 6. In ¶ 0092, reproduced below, Ellis lists a number of items that the RPGAD 24 may be, but specifically does not mention a mobile phone:

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[0092] An illustrative arrangement for remote program guide access device 24 is shown in FIG. 5. As shown in FIG. 5, remote program guide access device 24 may be any suitable personal computer (PC), portable computer (e.g., a notebook computer), palmtop computer, handheld personal computer (H/PC), display remote, touch-screen remote, automobile PC, personal digital assistant (PDA), or other suitable computer based device. Remote program guide

As such, Ellis does not explicitly teach that the RPGAD 24 may be a mobile phone.

Ellis also does not imply that the RPGAD 24 could be a mobile phone. To find that Ellis implies that the RPGAD 24 may be a mobile phone, the Action cites a voice processor and a speaker, which is described in ¶108 of Ellis in the context of "voice recognition software."

[0108] When the user wishes to access the features of the program guide via remote program guide access device 24, the user may issue an appropriate command using user interface 52 (FIG. 5). For example, if the user wishes to view programming information, a "guide" key on user interface 52 can be used. If, for example, user interface 52 includes a microphone and uses suitable voice recognition software, the user may speak a predetermined command into the microphone. Such an interface is especially useful in environments where remote program guide access device 24 must be operated without the use of one's hands, as with an automobile PC.

A mobile phone at least has the capability to place a phone call over a telephone network. Ellis does not, however, disclose or imply that the RPGAD 24 has the capability to place a phone call over a telephone network and hence one of ordinary skill in the art at the time of the claimed invention would not conclude that the RPGAD 24 of Ellis could be a mobile phone.

Even if the Office disagrees, the Action fails to address how the user television equipment 22 is a mobile phone in the manner claimed. Implicitly, the Action has found that the user television equipment 22 is the other claimed mobile phone as previous claim 1 recited a first mobile phone and a second mobile phone. Action at 5-6. In effect, the Action has found that the user television equipment 22, which Ellis describes as being controlled by the parental control settings received from the RPGAD 24, is a mobile phone being inhibited in the same manner as the claimed first mobile phone. Applicant respectfully disagrees.

Ellis does not explicitly indicate that the user television equipment 22 can be a mobile phone. Ellis illustrates the user television equipment 22 in FIG. 3, reproduced below.

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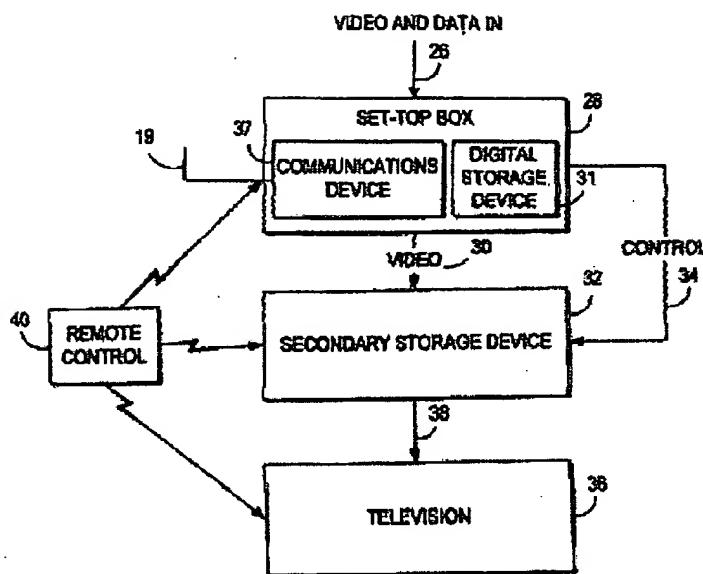


FIG. 3

Clearly, Ellis does not teach that the user television equipment 22 is a mobile phone.

Ellis also does not imply that the user television equipment 22 is a mobile phone. Ellis describes the user television equipment 22 in ¶ 0080 reproduced below.

[0080] An illustrative arrangement for user television equipment 22 is shown in FIG. 3. User television equipment 22 of FIG. 3 receives video and data from television distribution facility 16 (FIG. 1) at input 26. During normal television viewing, the user tunes set top box 28 to a desired television channel. The signal for that television channel is then provided at video output 30. The signal supplied at output 30 is typically either a radio frequency (RF) signal on a predefined channel (e.g., channel 3 or 4), or a analog demodulated video signal, but may also be a digital signal provided to television 36 on an appropriate digital bus (e.g., a bus using the Institute of Electrical and Electronics Engineers (IEEE) 1394 standard, (not shown)). The video signal at output 30 is received by optional secondary storage device 32.

Nowhere does Ellis imply that that user television equipment 22 can be a mobile phone. Thus, Ellis fails to disclose a second mobile phone transmitting inhibit rule data directly to a first mobile phone. Ellis also fails to disclose inhibit rule data configured to instruct the first mobile phone to inhibit certain functions of the first mobile phone so that the functions are no longer

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operable. Ellis describes parental controls for controlling user television equipment 22, not a mobile phone. As discussed above, Hind also fails to disclose these claim features. Even if the Office finds that Hind provides support for direct communication between two mobile phones, Hind does not disclose transmitting inhibit rule data from a second mobile phone that is configured to instruct a first mobile phone to inhibit certain functions of the first mobile phone so that the functions are no longer operable. Accordingly, neither reference discloses the transmitting inhibit rule from a second mobile phone to a first mobile phone in the manner claimed. Because the combination of Hind and Ellis, even if proper, fails to disclose all of the features recited in claim 1, a *prima facie* case of obviousness for a rejection under 35 U.S.C. § 103 cannot be established.

Lastly, Steele, even if combined with Hind and Ellis, would not cure the deficiencies of the Hind and Ellis combination. Notably, Steele fails to teach or suggest “transmitting inhibit rule data directly from said second mobile phone to said first mobile phone via the secured communication link” in the manner claimed. As such, Steele, even if combined with Hind and Ellis, would not cure the deficiencies of the Hind and Ellis combination.

Accordingly, claims 1-7, 10-15, 17, 28, 94-102, 106, and 108-109 are allowable over the combination of the cited references.

## 2. Comments on Claims 9, 36, 44, 53, 63, 74, 86, and 92

Claim 9 recites “receiving inhibit rule data directly from said mobile remote control at said mobile phone via the secured communication link” in combination with “inhibiting certain functions of said mobile phone according to said transmitted inhibit rule data so that said functions are no longer operable by said controller.” Claims 36, 44, 53, 63, 74, 86, and 92 depend from claim 9. For at least the following reasons, the combination of Ellis and Hind, even if proper, does not teach or suggest the above identified combination of features recited in claim 9.

On page 7, the Action correctly notes that Hind is “silent to inhibiting certain functions of the first mobile phone so that the functions are no longer operable.” As discussed above, Ellis describes a user television equipment 22 receiving parental control information from a RPGAD 24, but fails to disclose that the user television equipment 22 can be a mobile phone. Thus, the combination of Ellis and Hind, even if proper, fails to teach or suggest “receiving inhibit rule data directly from said mobile remote control at said mobile phone via the secured communication link” in combination with “inhibiting certain functions of said mobile phone

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according to said transmitted inhibit rule data so that said functions are no longer operable by said controller.” Therefore, a *prima facie* case of obviousness to reject claim 9 cannot be established.

Lastly, Steele, even if combined with Hind and Ellis, would not cure the deficiencies of the Hind and Ellis combination. As such, Steele, even if combined with Hind and Ellis, would not cure the deficiencies of the Hind and Ellis combination. Accordingly, claims 9, 36, 44, 53, 63, 74, 86, and 92 are allowable over the combination of the cited references.

### 3. Comments on Claims 103-105, 107, 110-112, 114-131

Amended claim 103 recites a controller configured to “process inhibit rule data received from the second mobile phone via the secured communication link” and to “inhibit certain functions performed by the functional unit so that the functions are no longer operable based on said transmitted inhibit rule data.” Claims 104-105, 107 110-112, 114-131 depend from claim 103. For at least the following reasons, the combination of Ellis, Hind, and Steele, even if proper, does not teach or suggest the above identified combination of features recited in claim 103.

On page 10, the Action correctly notes that Hind is “silent to inhibiting certain functions of the first mobile phone so that the functions are no longer operable.” As discussed above, Ellis describes user television equipment 22 receiving parental control information from a RPGAD 24, but fails to teach or suggest that the user television equipment 22 can be a mobile phone. Thus, the combination of Ellis and Hind, even if proper, fails to teach or suggest a controller configured to “process inhibit rule data received from the second mobile phone via the secured communication link” and to “inhibit certain functions performed by the functional unit so that the functions are no longer operable based on said transmitted inhibit rule data.” Therefore, a *prima facie* case of obviousness to reject claim 103 cannot be established.

Lastly, Steele, even if combined with Hind and Ellis, would not cure the deficiencies of the Hind and Ellis combination. Accordingly, claims 103-105, 107 110-112, 114-131 are allowable over the combination of the cited references.

### 4. Comments on Claims 132-134, and 136-147

Amended claim 132 recites “processing inhibit rule data directly received via the secured communication link from the second mobile phone at the first mobile phone” in combination with “inhibiting certain functions of the first mobile phone based on the inhibit rule data so that the functions are no longer operable by the processor.” Claims 133-134, and 136-147 depend

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from claim 132. For at least the following reasons, the combination of Ellis and Hind, even if proper, does not teach or suggest the above identified combination of features recited in claim 132.

On page 12, the Action rejects claim 132 for the same reasons as claim 1. In the rejection of claim 1, the Action correctly notes that Hind is “silent to inhibiting certain functions of the first mobile phone so that the functions are no longer operable.” Action at 5. As discussed above, Ellis describes a user television equipment 22 receiving parental control information from a RPGAD 24, but fails to teach or suggest that the user television equipment 22 can be a mobile phone. Thus, the combination of Ellis and Hind, even if proper, fails to teach or suggest “processing inhibit rule data directly received via the secured communication link from the second mobile phone at the first mobile phone” in combination with “inhibiting certain functions of the first mobile phone based on the inhibit rule data so that the functions are no longer operable by the processor.” Therefore, a *prima facie* case of obviousness to reject claim 132 cannot be established.

Lastly, Steele, even if combined with Hind and Ellis, would not cure the deficiencies of the Hind and Ellis combination. Accordingly, claims 132-134, and 136-147 are allowable over the combination of the cited references.

### New Claims

New claims 149-151 have been added. New claim 149 depends from claim 1 and recites “wherein the second mobile phone is configured to indirectly communicate with the first mobile phone via a telephone network.” Claim 149 is independently allowable over the combination of Hind, Ellis, and Steele, even if proper. Notably, the combination fails to teach or suggest “transmitting inhibit rule data directly from said second mobile phone to said first mobile phone via the secured communication link,” as recited in claim 1, in combination with “wherein the second mobile phone is configured to establish a telephony connection to indirectly communicate with the first mobile phone via a telephone network,” as recited in claim 149. As discussed above, the combination of Hind, Ellis, and Steele fails to describe transmitting inhibit rule data directly between mobile phones via a secured communication link. Additionally, the cited combination of references further fails to teach or suggest both direct and indirect communication. Notably, claim 149 requires transmitting inhibit rule data directly between mobile phones via a secured communication link, and a configuration for indirect

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communication between the mobile phones via a telephone network. The combination of Hind, Ellis, and Steele, even if proper, fails to disclose any such direct and indirect communication in the manner claimed. Thus, the combination of Hind, Ellis, and Steele, even if proper, does not teach or suggest the features recited in claim 149 and hence is allowable. Claims 150 and 151 are allowable for analogous reasons.

**Conclusion**

All rejections having been addressed, Applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,  
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